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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,346	06/21/2001	Dwight Randall Smith	PF02258NA	5638
20280	7590	05/19/2004	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			RAMOS FELICIANO, ELISEO	
			ART UNIT	PAPER NUMBER
			2681	5

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,346

Applicant(s)

SMITH ET AL.

Examiner

Eliseo Ramos-Feliciano

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/21/01
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "26". Figure 3 illustrates IM access portal 26 according to page 6, lines 9-10 of the specification; however, Figure 3 contains reference number "22", not "26". On the other hand, "22" is not mentioned under the explanation of Figure 3 in the specification, page 6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 5-6 and 16-17** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding **claims 5-6 and 16-17**, the phrase "about less" renders the claim indefinite because it makes reference to an object that is variable, extends the scope of the expression so as to render it indefinite, and the specification lacks some standard for measuring the degree intended. See MPEP § 2173.05(b).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 5-12, and 16-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsou et al. (US Patent Application Publication Number US2002/0184089A1) in view of Heath et al. (US Patent Number 6,636,872).

Regarding claim 1, Tsou et al. discloses an apparatus for providing Instant Messaging (IM) services in a wireless communication system (300), as shown in Figure 3; see the abstract.

The invention includes:

an IM data storage device (204, 316) for storing new presence information (first IM contact data) associated with an IM client (212),

an IM server (210) to access the IM data storage device (214, 316) and retrieve the presence information (first IM contact data) associated with the IM client (212),

an IM access portal (302) in operable communication with the IM server (210) and for accessing previous presence information (second IM contact data) associated with the IM client (212) and transmitted to a wireless device (308, 208) of the IM client (212) during a prior wireless connection. The IM access portal (302) is further configured to transmit an update of the presence information to the wireless device (308, 208); the update being based on the new presence information. See Figure 3 and particularly paragraphs 0002-0003, 0013, 0041-0047, 0050-0052.

Such updated presence information can be characterized as “difference IM contact data”. However, Tsou et al. fails to particularly disclose that the updated or difference IM contact data is produced from a comparison of the first IM contact data and the second IM contact data.

Heath et al. teaches a simple method for transmission of updated data, file, or information from a server to a client. The existing version of the data/file/information is compared with the updated data/file/information. The differences therebetween are determined and transmitted. Only the difference, i.e., those portions not found in the existing version, are transmitted. (See column 1, lines 45-50). Therefore, the updated data transmission consist of difference data only. The motivation taught by Heath et al. is that generally an update consists of changing only small portions of the original data (column 1, lines 35-36), and to better compress the update to a fraction of the actual size (column 1, line 44).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compare the first IM contact data with the second IM contact data, and transmit only the differences, those portions not found in the original data ("difference IM contact data"), because generally an update consists of changing only small portions of the original data, and for achieving a better compression technique, as suggested by Heath et al.

As to **claim 12**, it is the corresponding method claim of apparatus *claim 1*; therefore, it is rejected for the same reasons set forth above.

Regarding **claims 5-6 and 16-17**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claims 1 and 12*). In addition, Tsou et al. teaches that the transmitted data is just an update and Heath et al. teaches that generally an update consists of changing only small portions of the original data (column 1, lines 35-36 of Heath et al.). Therefore, one can reasonably conclude that the difference (updated) IM contact data has "about less" addressing data than either the first IM contact data or the second IM contact data as claimed.

Regarding **claim 7**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claim 1*). In addition, Tsou et al. teaches that the invention further includes an IM access portal storage device (310, 312) for storing the second IM contact data. See Figure 3 and citations above.

Regarding **claims 8, 10-11, 18 and 20-21**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claim 1 and 12*). In addition, Tsou et al. teaches that the wireless device can be any portable wireless device. For example: cellular telephone, mobile PDA, or mobile radio. See Figure 1, paragraph 0002, 0004, etc.

With respect to **claims 9 and 19**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claims 1 and 12*). However, they fail to particularly disclose a two-way pager. But, as explained above, Tsou et al. teaches that the wireless device can be any portable wireless device. The examiner contends that such teaching suggests a two-way pager as claimed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the subject invention on a two-way pager for the advantage of better portability and wide availability, since Tsou et al. already suggests a portable wireless device.

7. **Claims 2-4 and 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsou et al. and Heath et al. as applied to *claims 1 and 12* above, and further in view of Birkler et al. (US Patent Application Publication Number US2002/0129103A1).

Regarding **claims 2-4 and 13-15**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claims 1 and 12*). However, they fail to particularly disclose when to perform the comparison as defined by applicant.

Birkler et al. teaches a simple method for updating IM presence information (IM contact data) from a server to a client. The original version is compared with the new version when the client establishes connection. If they match, meaning they are the same, no update is needed, and, therefore, not provided; then a delay (predetermined interval) is established. If they do not match, meaning they are not the same, the update is immediately provided. In this way, the update is provided if the IM presence information (IM contact data) is altered. See paragraphs 0020-0023, abstract, and Figure 4. Therefore, Birkler et al. teaches to perform the update only when needed, in order to save system resources.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the subject comparison when the wireless device initially establishes connection, after a predetermined interval, and/or if the IM contact data is altered, because it is more efficient to be performed when it is needed and suggested by Birkler et al., in order to save system resources.

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barnert et al. (US Patent Number 6,239,793) see column 2, lines 50-62.

Conclusion

9. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A. Gary, can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf

May 14, 2004


ERIKA GABY
PATENT EXAMINER